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**MAR 11 2005**

**OFFICE OF PETITIONS**

In re Application of

Petersen

Application No. 09/938,669

Filed: 27 August, 2001

Attorney Docket No.: 60117.000004

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ON PETITION

This is a decision on the petition filed (with fee) via 18 January, 2005, under 37 C.F.R. §1.182 to withdraw the terminal disclaimers as to Application No. 09/938,667, Application No. 09/938,668, and Application No. 09/938,670.

The petition is **GRANTED**.

**BACKGROUND**

The petition alleges that Terminal Disclaimers required during prosecution as to the above-identified applications are no longer required after amendment(s) and the close of prosecution because claims previously covered by those Terminal Disclaimers have been cancelled.

The commentary at MPEP §1490 provides in pertinent part:

\* \* \*

***A. Before Issuance Of Patent***

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "un-happy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to

rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 C.F.R. 1.182 requesting withdrawal of the recorded terminal disclaimer.

\* \* \*

The Examiner has reviewed the record in the instant case and in the above-identified related cases and has approved the withdrawal of the Terminal Disclaimers as to Application No. 09/938,667, Application No. 09/938,668, and Application No. 09/938,670. (A copy of the Examiner's authorization is being forwarded to be entered into the record.)

The instant application is released to Technology Center 1600 for processing consistent with the instant decision before being released to the Publications Branch to be processed into a patent in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

Gillon, John

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**From:** Azpuru, Carlos  
**Sent:** Thursday, March 10, 2005 4:06 PM  
**To:** Gillon, John  
**Subject:** RE: 09/938,669

John,

The correct serial number should be 09/938,670. Sorry about the typo! Carlos Azpuru

-----Original Message-----

**From:** Gillon, John  
**Sent:** Thursday, March 10, 2005 4:00 PM  
**To:** Azpuru, Carlos  
**Subject:** RE: 09/938,669  
**Importance:** High

Carlos, did you mean to refer to 09/938,670 below, or were you correct as to 09/938,970

The petition refers to 09/938,670

-----Original Message-----

**From:** Azpuru, Carlos  
**Sent:** Thursday, March 03, 2005 2:51 PM  
**To:** Gillon, John  
**Subject:** RE: 09/938,669

John,

The terminal disclaimer should be withdrawn in 09/938,667 and 09/938,668 since applicant has amended around the rejection. The claims in question in case 09/938,970 have also been cancelled. So all three should be withdrawn. Thanks, Carlos Azpuru

-----Original Message-----

**From:** Gillon, John  
**Sent:** Thursday, March 03, 2005 10:42 AM  
**To:** Azpuru, Carlos  
**Cc:** Pearson, Charles; Lazarus, Ira  
**Subject:** 09/938,669  
**Importance:** High

Examiner,

The attorney is seeking to withdraw the terminal disclaimers in this case.

Do you approve? YES or NO?

Thanks!

**John J. Gillon, Jr., J.D., M.P.H.**

*Senior Attorney*

***US Patent and Trademark Office***

Commissioner for Patents

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